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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/534,433 03/23/00 PATTON

D 80521F-P

EXAMINER

001333
PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER NY 14650-2201

QM32/0504

HENDERSON, M

ART UNIT

PAPER NUMBER

3722
DATE MAILED:

05/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/534,433

Applicant(s)

PATTON, DAVID L.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2001 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____ .

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-11 have been canceled. Claims 15-17, 19-22 and 26-33 have been amended to overcome the previous 35 USC 112 rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore et al.

Gilmore et al discloses in Fig. 3 and 4, a stamp comprising a first indicia (125) and a second indicia (152), wherein either the first or second indicia can be invisible under normal viewing conditions, unscannable (as stated in Col. 4, line 64, "UV characteristics which may be detected by a compatible reader") and has an ink which can be seen under UV light (as stated in Col.4, lines 62-67).

However, Gilmore et al does not disclose a first and second indicia identifying stamp as a valid limited edition, first indicia being a visible unique ID, a third indicia wherein the indicia is invisible to the eye, unscannable and derived from ink that can be seen under UV or infrared light.

In regards to Claims 12, 13, 15 and 19, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia, since it would only depend on the **intended use of the assembly and the desired information to be displayed**. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there

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appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to Claims 19, 20 and 22, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of indicia, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

3. Claims 23-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Brasington et al in view of Gilmore et al.

Brasington et al discloses in Fig. 5 and 8, a sheet of stamps, each stamp comprising a first visible indicia (69), a second indicia (73), and a third indicia (71) provided for identifying the vendor/printer machine (Col. 5, lines 11-34) and location.

However, Brasington et al does not disclose a first and second indicia which identifies a stamp to be a limited edition, a second indicia which is invisible under normal viewing and is made using an ink that can be seen under UV or infrared light, a first indicia comprising a unique ID, and a third invisible made with ink that can be seen when viewed by UV or infrared light.

Gilmore et al discloses in Fig. 3 and 4, a stamp comprising a first indicia (125) and a second indicia (152), wherein either the first or second indicia can be invisible under normal viewing conditions, unscannable (as stated in Col. 4, line 64, "UV characteristics which may be

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detected by a compatible reader”) and has an ink which can be seen under UV light (as stated in Col.4, lines 62-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brasington et al’s stamp sheet to include stamps having indicia which can only be seen under UV conditions as taught by Gilmore et al for the purpose of determining whether the correct postage has been applied to a postal letter.

4. In regards to **Claims 23, 24, 26 and 30**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

5. In regards to **Claims 27-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of indicia, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Response to Arguments

6. Applicant's arguments filed on February 23, 2001, have been fully considered but they are not persuasive.

In response to applicant's argument that the Gilmore et al reference does not teach or suggest ink not visible under normal viewing conditions, the examiner submits that after further review of the specification, (wherein the applicant states on page 5, lines 26 and 27, "The information printed in the third indicia area (40) may be eye readable or not visible to the eye under normal viewing conditions such as infrared or UV lights. In the embodiment illustrated the marking material is a fluid, and in particular an infrared or UV ink.") the Gilmore reference does indeed disclose an ink invisible under normal viewing conditions as stated in Col.4, lines 62-67.

In response to applicant's argument that the Gilmore et al reference does not teach or suggest that the stamp is a limited edition stamp, nor does it teach that indicia, when scanned will allow reproduction, the examiner submits a recitation of the intended use (stamp being a limited edition stamp) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The examiner also submits that the features upon which applicant relies (i.e., indicia, when

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scanned will allow for reproduction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 29, 2001



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